

REMARKS

Reconsideration and allowance of the subject application are respectfully solicited.

Claims 7, 8, 14, and 15 are pending, with Claim 7 being independent. Claims 7, 14, and 15 have been amended.

Claims 7 and 8 were provisionally rejected under the judicially-created doctrine of non-statutory, obviousness-type double patenting over Claims 1 through 4 of Appln. No. 11/118,401. All rejections are respectfully traversed, and are submitted to have been obviated by the filing herewith of a Terminal Disclaimer that makes reference to said application.

Claims 7, 8, 14, and 15 were rejected under 35 U.S.C. § 103 over EP 1357138A1 ("EP '138") in view of the article by Percec, et al. All rejections are respectfully traversed, and are submitted to have been obviated by the filing herewith of a sworn translation of the second priority application, Japanese Patent Application No. 2003-307618 filed August 29, 2003, from which application the subject application claims priority under 35 U.S.C. § 119, and which application pre-dates the October 29, 2003 publication date of EP '138, thereby precluding application of that document under 35 U.S.C. § 102(a). MPEP 201.15. With respect to Claim 7, for example, the Examiner's attention is directed, e.g., to General Formula (1) at, e.g., page 2 of the sworn translation (among other substituents, X may be, e.g., $-(CH_2)_m-(O)_n-(CH_2)_q-$), and Applicant submits that General Formula (1) encompasses (i.e., includes) Claim 7's Formula (4). With respect to Claim 15, for example, the Examiner's attention is directed, e.g., to General Formula (2) at, e.g., page 3 of the sworn translation, and to paragraphs [0027] and [0037]. Favorable consideration is earnestly solicited. For completeness' sake, Applicants are also enclosing a sworn translation of the first priority application, Japanese Patent Appln. No. 2003-

129997 filed May 8, 2003.

Claims 1 through 15 were variously rejected under 35 U.S.C. §§ 102 and 103 over US 2003/0179268 A1 (Koga, et al.). All rejections are respectfully traversed.

Claim 1 recites, *inter alia*, a water-insoluble coloring material in combination with a poor medium for the water-insoluble coloring material and/or a salt (with dynamic surface tension as claimed).

However, Applicants respectfully submit that Koga, et al. fails to disclose or suggest at least the above-discussed claimed combination of features as recited, *inter alia*, in Claim 1. Applicants respectfully submit that by means of such features, to achieve an objective of providing an aqueous ink having such excellent properties that both image density and fixing ability are excellent irrespective of the kind of a recording medium, it is important to suitably control aggregation of a coloring material in a recording medium and the behavior of an ink from application to the recording medium to completion of permeation (e.g., page 10, line 24 to page 11, line 1), and a mechanism with which the meritorious effects of the present invention are obtained is described at, e.g., page 20, line 14 to page 27, line 15, and Applicants respectfully submit that if a constituent feature of the present invention is missing, the meritorious effects cannot be obtained, as can be seen from the result of Examples and Comparative Examples.

Applicants respectfully submit that Koga, et al. does not disclose any specific example that satisfies all of the Claim 1 features, as discussed above.

In this regard, turning first to the “poor medium” feature, Applicants respectfully submit that Koga, et al.’s water-insoluble coloring material CAB-O-JET 300 Black is used only for the black ink of the ink sets of Examples 1, 2, and 4, and Comparative Examples 1-5, and the water-

soluble organic solvents used in the black ink are dipropylene glycol (in Examples and part of Comparative Examples, which solvent is said to be most suitable in view of the permeation velocity into the recording paper [0032]), diethylene glycol diethyl ether (Comparative Example 4), tripropylene glycol methyl ether (Comparative Example 5), and glycerol. However, Applicants respectfully submit that none of them is a poor medium to CAB-O-JET 300 Black, and Applicants submit that Koga, et al. gives no motivation to arrive at the idea of selecting a poor medium among water soluble organic solvents in view of the relationship with respect to the water-insoluble coloring material.

Turning next to the “salt” feature, Applicants respectfully submit that Koga, et al. states, e.g., "When the water base ink for ink-jet recording of the present invention is used for the ink-jet recording system of the type in which the recording liquid is electrically charged, a specific resistance-adjusting agent including, for example, inorganic salts such as lithium chloride, ammonium chloride, and sodium chloride may be added" (paragraph [0040], lines 1-6), but that no salt is used in any of the Examples and the Comparative Examples of Koga, et al., and in Applicants' view, such a statement does not suggest *selecting* from the disclosure of Koga, et al. the above-discussed claimed combination of features including a water-insoluble coloring material and salt.

Applicants further respectfully submit that there has been no showing of any indication of motivation in the cited document that would lead one having ordinary skill in the art to arrive at the above-discussed combination of claimed features as recited, *inter alia*, in Claim 1.

The dependent claims are also submitted to be patentable because they set forth additional aspects of the present invention and are dependent from independent claims discussed above.

For example, Claims 4 and 5 recite, *inter alia*, specified conditions, and Applicants respectfully submit that such self-dispersion pigments particularly effectively exhibit the advantageous effects of the present invention, with a mechanism by which the meritorious effects are obtained being discussed at, e.g., page 52, line 11 through page 67, line 6. However, Applicants respectfully submit that Koga, et al.'s CAB-O-JET 300 Black used in the Examples does not satisfy the constituent features of Claims 4 and 5 and never suggests the combination of the claimed self-dispersion pigment and a poor medium and/or a salt. Therefore, separate and individual consideration of each dependent claim is respectfully requested.

REQUEST FOR ENTRY OF AMENDMENT

This Amendment After Final Rejection is an earnest attempt to advance prosecution and reduce the number of issues, and is believed to clearly place this application in condition for allowance. Furthermore, Applicants respectfully submit that a full appreciation of these amendments will not require undue time or effort given the Examiner's familiarity with this application. Moreover, this Amendment was not earlier presented because Applicants earnestly believed that the prior Amendment placed the subject application in condition for allowance. Accordingly, entry of this Amendment under 37 C.F.R. § 1.116 is respectfully requested.

CONCLUSION

Applicants submit that this application is in condition for allowance, and a Notice of Allowance is respectfully requested.

Applicants' undersigned attorney may be reached in our Washington, D.C. office by telephone at (202) 530-1010. All correspondence should to be directed to our below listed address.

Respectfully submitted,

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